

REMARKS

Claims 1-20 are all the claims pending in the application.

Claim 2 has been canceled without prejudice or disclaimer and the limitations of claim 2 have been added to claim 1.

New claims 21-24 have been added to provide addition claim coverage.

Applicant thanks the Examiner for indicating that claims 3-9, 11, 12 and 14-20 contain allowable subject matter. Claim 3 has been rewritten in independent form. However, Applicant has not rewritten the remaining claims because independent claim 1 should be allowable for the reasons discussed below.

OBJECTIONS TO THE SPECIFICATION, CLAIMS AND ABSTRACT

The Examiner has made several objections to the specification. The first objection is that the specification is allegedly unclear as to whether figure 1 is prior art or the invention. Applicant believes that the specification is clear and provides the following clarification for the Examiner.

Figure 1 is a block diagram of an exemplary custom LSI that is used to describe both the prior art and applicant's invention. Whether it represents the prior art or the invention depends on the circuits that are used in the boundary-scan device. For example, prior art boundary-scan cell 40 (figure 7) could be used for each of the boundary-scan cells BI₁, BI₂, etc. shown in figure 1. Likewise, boundary-scan cell 120 could also be used for each of the boundary-scan cells BI₁, BI₂, etc. shown in figure 1. Therefore, Applicant requests that the objection be withdrawn.

The other two objections relate to paragraph [0035] and the Abstract. Applicant has amended the specification and Abstract to address the objections. Therefore, Applicant requests that the objections be withdrawn.

The Examiner has objected to the preamble of claim 1 as being unclear. Applicant has amended claim 1 to address the objections. Therefore, Applicant requests that the objection be withdrawn.

Applicant has also amended claims 1, 4, 7 and 10 to replace “circuitries” with “circuits” to better conform the claims to the English language.

Finally, the Examiner has not indicated that the drawings have been approved. Applicant requests that the Examiner approve the drawings in the next Office Action.

35 U.S.C. § 102 REJECTIONS

The Examiner has rejected claims 1, 10 and 13 under 35 U.S.C. § 102(b) as being anticipated by applicant’s admitted prior art (figures 1 and 8). Applicant traverses these rejections because the admitted prior art fails to disclose or suggest all of the claim limitations.

Claim 1 now has the claim 2 limitation of a gate having an input coupled to a data signal output and a scan cell coupled to an output of the gate. An example of this would be gate 130 in figure 2. Input 138 of gate 130 is coupled to signal output end 126 and output 142 of gate 130 is coupled to scan cell 132.

On the other hand, in figure 7, gate 50 does not have any inputs that are coupled to the signal output end 46. Rather, input 56 of gate 50 is coupled to signal input end 44 and selector 54.

AMENDMENT UNDER 37 C.F.R. § 1.111
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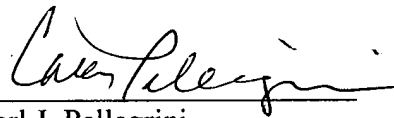
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Therefore, for at least these reasons, we request that the Examiner withdraw the prior art rejection of independent claim 1 and claims 10 and 13, which depend from claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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